BRIEF IN SUPPORT OF PETITION

Opinions in the Action

The decision of the District Court (R. 10-21) is reported in 59 F. Supp. 820 and the opinion of the Court of Appeals (R. 431-46) is reported in 154 F. (2d) 48.

Jurisdiction

The opinion (R. 431) and the judgment (R. 447) of the Court of Appeals were filed and entered on March 14, 1946.

A petition for rehearing as to the issue of infringement was filed by petitioner on March 28, 1946 and an order denying this petition was entered on April 16, 1946 (R. 447).

The statute which accorded jurisdiction is Section 240 (a) of the Judicial Code (28 U. S. C. A. § 347).

Decisions of this Court which are believed to sustain jurisdiction follow:

Mackay Radio & Telegraph Co. v. *Radio Corporation of America*, 306 U. S. 86, at 89.

Lincoln Engineering Co. v. *Stewart-Warner Corp.*, 303 U. S. 545, at 546.

Carbice Corporation of America v. *American Patents Development Corporation*, 283 U. S. 27.

De Forest Radio Co. v. *General Electric Co.*, 283 U. S. 664.

Muncie Gear Works, Inc., et al. v. *Outboard Marine & Mfg. Co., et al.*, 315 U. S. 759.

Schriber-Schroth Co. v. *Cleveland Trust Co.*, 305 U. S. 47.

Sinclair & Carroll Co., Inc. v. *Inter-Chemical Corp.*, 325 U. S. 327.

Statement of the Case

The foregoing petition contains a summary of some of the material facts necessary to an understanding of the reasons relied upon for the allowance of the petition.

The Bower patent (R. 155), for a permanent magnetic chuck, may be understood from Figs. 2 and 2ª of its drawings. The permanent magnets 1 are of W-shape and each magnet has three poles. The permanent magnets are housed in a casing 4. A face plate 3 is provided for the casing 4. Pole pieces 2 are cast in the face plate 3 which supports the work piece. When the permanent magnets 1 are in the position shown in Fig. 1 the pole pieces 2 contact with the magnets 1 and admit of magnetic flux passing through a work piece placed upon the plate 3.

When the magnets 1 are moved to the right, as shown in Fig. 2ª, the pole pieces 2 remain in contact with the magnets 1 but the pole pieces 2 bridge the gaps between adjacent poles of the magnets 1. When in this position almost all of the magnetic flux passes through the pole pieces 2 and only a very small amount passes through the work piece. This is to shunt the flux from the work piece.

When in the off position, Fig. 2ª, the face plate 3 may not be lifted off for the reason that flux passes through the pole pieces 2 and this prevents its removal.

Defendant's device is shown in Exhibit H (R. 364) in the "off" and "on" positions. It is also shown in Exhibit N (R. 425) and Exhibit S (R. 426). It comprises an assembly of permanent magnets. At their upper ends the magnets terminate in tapered soft metal. Alternating with the magnets are conducting bars of soft metal. The conductor bars are narrower than the magnets. The magnets and conductor bars are enclosed in a casing. The plate comprising the base of the casing, together with the magnets and conductor bars, form a path for the magnetic flux (R. 121). The face plate is made of aluminum, a non-conductor of magnetism. A series of conductor bars or pole pieces are arranged in slots in the face plate.

When defendant's chuck is in the "on" position the bottoms of the several pole pieces in the face plate are in register with the tops of the magnets and the conductor bars (Exhibit H, R. 364).

In the "off" position the bottoms of the pole pieces are positioned between the upper ends of the magnets and conductor bars. An air space exists between the magnets and the conductor bars. No shunt for the flux is provided by petitioner. There is no metallic or other path provided for the flux as in the Bower device. The well known horseshoe permanent magnet is all that is present in the "off" position of petitioner's device for the flux passes from a magnet across an air space to the conductor bar and base completing the magnetic circuit.

The face plate, including the pole pieces, may be removed when petitioner's chuck is in the "off" position. This is because little flux passes to the pole pieces.

Electromagnetic chucks and permanent magnetic chucks and their operation were old and well known prior to Bower (finding 9, R. 11). Permanent magnets were used but "they would become weak" (R. 105). The art awaited a suitable metal. Such metal was produced but not by Bower. It was known by the name "Alnico" (R. 105). It is a ferrous alloy containing aluminum, nickel, cobalt and iron. With the advent of Alnico permanent magnets could be safely used. Respondents confirm the fact in their leaflet (Exhibit F; R. 325) in which they state:

> "The magnets of a special alloy are many times stronger than magnets previously available and last indefinitely. The chuck has strong holding power, adapting it for grinding operations and, also, for light cuts on lathe work and other machine operations."

Petitioner in its catalog (Exhibit 17; R. 210-11) states:

> "The recent development of special alloys having *permanent* magnetic properties to a very high degree, has made possible the modern permanent magnetic chuck. * * *

> "* * * Recent developments in magnetic alloys have made possible the production of permanent magnets of great power and retentivity, thus permitting the use of permanent magnet devices of unusual utility and simplicity."

The Court of Appeals did not mention the development of suitable magnetic alloy which made possible the "production of permanent magnets of great power and retentivity".

When the suitable alloy was produced it was the work of a mechanic to use it in a permanent magnet.

Varley prior patent (R. 332) of 1906 shows a circuit controller in which a permanent magnet is employed.

Hanson patent (R. 338) of 1911 shows an electromagnetic chuck with alternate north and south poles. They are separated by narrow non-magnetic material. The face plate is movable and it has separate pole pieces of high permeability magnetic material separated by narrow pieces of non-magnetic material. Each of the pole pieces registers with one of the several poles of the magnet. Movement of the movable pole piece results in making or breaking of contact between the magnets and pole pieces. There is a striking analogy between Hanson and the Bower patent. In Fig. 2 of Bower the pole pieces 2 are separated by narrow magnetic strips 3.

Bing patent (R. 348) of 1929 shows an electromagnetic chuck. It is circular in form but the same construction may be used in a rectangular form. A holding or face plate 1 is placed above cores 8. Rings 10 of magnetizable material are provided in the face plate 1—one ring for each of the three magnets 8. The rings 10 are in reality separate pole pieces. In Bing electric current may be on at all times and for removing work pieces from plate 1 the plate is moved with respect to magnets 8 so that the work piece is brought to a position in a neutral zone where the flux is neutralized and the work may be removed.

Edwards British patent (R. 352) is for an engineer's T square and drawing board. A permanent magnet 10 is

provided to hold the T square in close association with the edge of the drawing board. In order to release or modify the grip of the magnetism on the held piece, Edwards uses a magnetic shunt to perform the same function that Bower performs. The permanent magnet 10 will contact and hold the metal strip 14. Edwards provides means to shunt the flux of the permanent magnet out of the strip 14—the work piece.

The Court of Appeals stated (R. 442-3) that Edwards is concerned with "comparatively weak magnetic forces", that for all that appears Edwards was only "a paper patent" and that Edwards is in "an art far removed from chucks". It is not material whether or not a prior patent has been used or is a so-called paper patent. It is, nevertheless, pertinent for what it shows. It is idle to consider a drawing board and T square remote from any mechanical or electrical equipment. Drawings boards and T squares are always found in machine shops where devices, machinery and equipment are laid out on drawing boards before construction is begun.

Specification of Errors

1. The Court of Appeals erred in that it did not apply the decision of this Court which requires a high standard of invention for the grant of a valid patent (enunciated in full effect in the *Cuno Engineering Corp.* v. *The Automatic Devices Corp.*, 314 U. S. 84) and in sustaining the Bower patent in suit for a purported invention since it is merely for an improvement that is clearly within the skill of mechanics in the art.

2. The Court of Appeals erred in not applying the decisions of this Court (*I. T. S. Rubber Co.* v. *Essex Rubber Co.*, 272 U. S. 429, at 443-4, and *Exhibit Supply Co.* v. *Ace Patents Corporation*, 315 U. S. 126, at 136-7) which require that limitations embodied in the claims of the Bower patent in suit during prosecution of the application

therefor in the Patent Office, and in according scope to claims of the Bower patent in suit without regard to the limitations imposed therein during the prosecution of the application for the Bower patent.

3. The Court of Appeals erred in determining the issue of infringement when such issue had not been determined by the District Court and in that it did not remand the action to the District Court with directions to determine said issue.

ARGUMENT

POINT I

The decision of the Court of Appeals (R. 431-46) is in conflict with the decisions of this Court and with decisions of the United States Circuit Court of Appeals for the Second Circuit. All lower Federal Courts and the public would be aided by a determination of the conflict of decisions by this Court.

The Court of Appeals recognized that a higher standard for invention is required. This is evidenced by its decisions in *Anderson Co.* v. *Lion Products Co.*, 127 F. (2d) 454, 457, and *Bellavance* v. *Frank Morrow Co.*, 140 F. (2d) 419, 423.* It stated that it is presented "with the question whether the Supreme Court in the *Cuno* case** intended

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* In the *Bellavance* case the Court of Appeals received and considered a motion to reconsider its denial of plaintiff's petition for rehearing. The motion to reconsider was tendered in view of the decision in *Goodyear Tire & Rubber Co., et al.* v. *Ray-O-Vac Co.*, 321 U. S. 275. The Court of Appeals stated in its opinion that it was urged that the decision of the *Goodyear* case "in practical effect" overruled the *Cuno* case and the trend of the Supreme Court "toward an ever stricter application of the invention". The motion to reconsider the petition for rehearing was denied—141 F. (2d) 378. Thereafter this Court denied a petition for certiorari—322 U. S. 742.

** *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84.

to establish for the future a new and higher standard of invention than had prevailed in the past" and it overruled its prior decisions in the said *Anderson* and *Bellavance* cases and held that this Court did not by the *Cuno* decision require a higher standard for invention. The decision of the Court of Appeals is at variance with the decision of this Court in the *Cuno* case as to standard of invention.

In the *Cuno* case this Court said that "the functions performed by Mead's combination were new and useful", that "Ingenuity was required to effect the adaptation" but that the fact that Mead's device was new and useful "does not necessarily make the device patentable" and that the ingenious adaptation was "no more than that to be expected of a mechanic skilled in the art". It is inherent in the decision of this Court in the *Cuno* case that a high standard for invention was laid down.

In *Picard* v. *United Aircraft Corporation,* 128 F. (2d) 632, the Court of Appeals for the Second Circuit had before it a patent for a lubricating system for a radial air-cooled aircraft combustion engine. The Court of Appeals said that the inventor's "disclosure was indubitably an improvement—deserves to be called inventions" but (p. 636)

> "We cannot, moreover, ignore the fact that the Supreme Court, whose word is final, has for a decade or more shown an increasing disposition to raise the standard of originality necessary for a patent. In this we recognize 'a pronounced new doctrinal trend' which it is our 'duty, cautiously to be sure, to follow not to resist'."

The Schenk patent was held to be invalid for lack of invention.

This Court denied a petition for writ of certiorari—317 U. S. 651.

This Court and the Court of Appeals for the Second Circuit are in accord that the standard for invention is higher than in the past.

The Court of Appeals in the case at bar flatly states that this Court in the *Cuno* case does not require a higher

standard for invention than in the past. The Court of Appeals will not require a higher standard for invention while this Court and the Court of Appeals for the Second Circuit will require a higher standard for invention. Complexity, difficulty and loss of property will result from the divergence of application of the rule of this Court. Consequently, it would be in the interest of the public to have the divergence of application of the law resolved by this Court.

POINT II

The decision of the Court of Appeals (R. 431-46) is in conflict with the decisions of this Court which require that limitations embodied in claims of a patent during its application stage must be considered and given effect in construing claims and when determining whether or not they are infringed.

During the prosecution of the application for the Bower patent the claims in issue, Nos. 1, 5, 7 and 14, were amended in view of the citation of prior patents by the Patent Office. Claim 1 was amended to provide for means operable at will for establishing "an auxiliary circuit to shunt the field out of the work". Claim 5 was amended to include "means * * * to shunt said flux". Claim 7 was amended to include "means * * * to establish an auxiliary circuit to cause magnetic flux to be diverted" and claim 14 was amended to include "means * * * to establish an auxiliary circuit for shunting the field out of the work".

Petitioner's device is shown in the drawing (Exhibit S; R. 426). It is seen therefrom that petitioner does not have an auxiliary circuit to shunt the field out of the work or for diverting the magnetic flux. In the "off" position of its chuck no "means"—a shunt or other circuit—is provided.

The Court of Appeals in construing claims 1, 5, 7 and 14 of the Bower patent did not heed the limitations embodied therein to avoid prior patents when in the application stage and would not accord to said claims "a narrow range of

equivalents", but accorded more generous treatment because "of the practical value and importance of the patentee's contribution" (R. 446). The limitations injected in the Patent Office were not enforced.

In *Motion Picture Patents Co.* v. *Universal Film Mfg. Co.*, 243 U. S. 502, this Court said (p. 510):

> "The scope of every patent is limited to the invention described in the claims contained in it read in the light of the specification."

The claim of a patent is the measure of the patentee's right to relief. What is not covered by a claim is open to the public.

McClain v. *Ortmayer*, 141 U. S. 419, 424.

It is unjust to the public and an evasion of the law to construe a claim in a manner different from the plain import of its terms.

White v. *Dunbar*, 119 U. S. 47, at 52.

In the device of the defendant, when in the off position, it does not have an auxiliary circuit to shunt the field out of the work or means to establish an auxiliary circuit for diverting magnetic flux called for by claims 1, 5, 7 and 14. When in the off position petitioner's chuck has an air space between the magnetic poles and the pole pieces. The magnetic flux is left free to travel where it will. In its off position petitioner's device is precisely the same as Fig. 1 of Exhibit 5 (R. 175). Fig. 1 of Exhibit 5 is "exactly similar to a well-known horseshoe magnet" (R. 30). The determination of the Court of Appeals as to the issue of alleged infringement of claims 1, 5, 7 and 14 of the Bower patent is opposed to the decisions of this Court in:

I. T. S. Rubber Co. v. *Essex Rubber Co.*, 272 U. S. 429, at 443-4.

Exhibit Supply Co. v. *Ace Patents Corp.*, 315 U. S. 126, at 136, 137.

The rule is stated in these decisions that whether or not the Patent Office was right or wrong in rejecting a claim in an application where an amendment is made which includes limitations the patentee is bound thereby, the public is entitled to rely upon the limitations and an interpretation of such claims when they mature in a patent may not be accorded scope to cover that which was excluded by the limitations embodied in order to obtain the patent.

The decision of the Court of Appeals on the issue of infringement is contrary to the decisions of this Court referred to. The interpretation accorded by the Court of Appeals to claims Nos. 1, 5, 7 and 14 of the Bower patent will result in injury to the public for it will preclude proper manufacture and sale of permanent magnetic chucks by manufacturers since they may not rely upon the limitations included in the said claims of the Bower patent. Proper competition will be precluded with loss and injury to the public unless corrected.

POINT III

The Court of Appeals determined the issue of infringement of claims 1, 5, 7 and 14 of the Bower patent even though the District Court had not considered and determined the issue of infringement of said claims and had not made findings of fact or conclusions of law with respect thereto.

Rule 52 of the Rules of Civil Procedure for the District Courts of the United States requires that in all actions tried upon the facts without a jury "the Court shall find the facts specially and state separately its conclusions of law thereon and direct the entry of the appropriate judgment".

The District Court did not determine the issue of infringement doubtless for the reason that it held the Bower patent to be invalid.

Neither the Court of Appeals nor the litigants had the benefit of consideration of findings of fact or conclusions

of law as to alleged infringement by defendant upon claims 1, 5, 7 and 14 of the Bower patent. A petition for rehearing was presented to the Court of Appeals as to its decision on the issue of infringement, but the petition was denied without opinion (R. 447).

The District Court directed (R. 21) an "appropriate decree in conformity with these findings and conclusions". All of them related to the invalidity of the Bower patent.

The function of appellate courts is to review judgments and the findings of the trial court relating thereto, and not to pass upon evidence *de novo*.

> *Webb* v. *Frisch et al.*, 111 F. (2d) 887 (C. C. A., Seventh Circuit).

In *Hazeltine Corporation* v. *Crosley Corporation*, 130 F. (2d) 344, the Court of Appeals for the Sixth Circuit had before it an appeal in a patent suit in which the complaint was dismissed on the ground of non-infringement. No "opinion was expressed, no findings of facts were filed, and no conclusions of law were stated by the district court with respect to the validity of the patent claims in issue" (p. 349). Appellant urged that the issue of validity be passed upon, but the Court concluded that it "cannot agree that such a procedure would be appropriate" (p. 349). The Court of Appeals, the reviewing court, would not adjudicate the issue of validity of the patent which had not been the subject of findings of the trial court.

In *Mayo, Commissioner of Agriculture of Florida* v. *Lakeland Highlands Canning Co. et al.*, 309 U. S. 310, this Court had before it an appeal from an award of an interlocutory injunction. A law of a state was held to be unconstitutional. Reversal was directed by this Court with instructions that if the interlocutory injunction is pressed, any action thereon "shall be upon findings of fact and conclusions founded upon the evidence, in accordance with Rule 52 (a) of the Rules of Civil Procedure".

In *Kelley et al.* v. *Everglades Drainage District*, 319 U. S. 415, this Court pointed out that (pp. 421-2) "it is not the function of this Court to search the record and analyze the evidence in order to supply findings which the trial court failed to make" and that "there must be findings, stated either in the court's opinion or separately, which are sufficient to indicate the factual basis for the ultimate conclusion" (p. 422).

In *City of Sumter et al.* v. *Spur Distributing Co.*, 110 F. (2d) 649 (C. C. A., Fourth Circuit), the appeal was from an order granting an interlocutory injunction. There were no findings of fact as required by Rule 52. The action was remanded "for further findings in accordance with a requirement of Rule 52 (a)".

The Court of Appeals should have remanded the issue of infringement of the Bower patent to the District Court to determine and make findings of fact and conclusions of law with respect thereto.

CONCLUSION

It is submitted that the petition for writ of certiorari should be granted.

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Dated, May 17, 1946.